



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
-----------------	-------------	----------------------	---------------------	------------------

09/854,199

05/11/2001

Ken Lang

KLQ-002

7926

959 7590 07/26/2007
LAHIVE & COCKFIELD, LLP
ONE POST OFFICE SQUARE
BOSTON, MA 02109-2127

EXAMINER

OYEBISI, OJO O

ART UNIT

PAPER NUMBER

3692

MAIL DATE

DELIVERY MODE

07/26/2007

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 09/854,199	Applicant(s) LANG, KEN	
	Examiner OJO O. OYEBISI	Art Unit 3692	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 15 May 2007.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-28 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-28 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

In the amendment filed on 05/10/2007, the following have occurred: claims 1, 12, 13, and 21 have been amended and claims 1-28 pending in the application.

Claim Rejections - 35 USC § 103

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
 2. Ascertaining the differences between the prior art and the claims at issue.
 3. Resolving the level of ordinary skill in the pertinent art.
 4. Considering objective evidence present in the application indicating obviousness or nonobviousness.
2. Claims 1-28 are rejected under 35 U.S.C. 103(a) as being unpatentable over Spencer (U.S PAT: 6,356,909) in view of Walker et al (Walker hereinafter, US PAT: 6196458).

Re claim 1. Spencer discloses a method for responding to an inquiry by an inquirer over a communication network, said method comprising the steps of providing the inquiry by the inquirer (i.e., users) that requires a response over the communication network, providing a response to the inquiry by a consultant (i.e., vendors) over the communication network, and exchanging the resource

between the consultant and the inquirer in response to the consultant responding to the inquiry (see abstract). Spencer does not explicitly disclose determining a resource exchangeable for a response to an inquiry by an inquirer. However, Walker discloses determining a resource exchangeable for a response to an inquiry by an inquirer (i.e., the central controller determines one or more upsells that correspond to the upsell offer condition. The upsells may be, for example, products complementary to previously-purchased products. The upsells are offered to the account holder by printing onto the billing statement indicia that specifies the upsells. Upon receiving an indication that an upsell was accepted, the upsell is provided to the account holder. The account holder may accept the upsell by appropriately modifying the billing statement and returning the statement with payment. The upsell is then provided, typically in the form of a reduced price at a point-of-sale terminal or a discount on a subsequent billing statement, see the abstract, also see col.5 lines 20-40. The examiner asserts that although it is stated that the account holder can respond to the upsell offering by manually modifying the billing statement, however, in a separate embodiment taught by Walker, the process can be achieved electronically, see col.7 lines 45-50). Thus it would have obvious to one of ordinary skill in the art combine the teachings of Spencer and Walker to generate sales to customers.

Re claim 2. Spencer further discloses the method wherein the communications network comprises the internet (see abstract, also see fig.1 element 221).

Re claim 3. Spencer further discloses the method further comprising the step of

Art Unit: 3692

establishing the resource exchanged between the consultant and the inquirer
(see abstract)

Re claim 4. Spencer further discloses the method wherein the step of establishing the resource comprises the step of establishing the resource by one of the consultant, the inquirer, and the provider (see abstract, also see col.2, lines 6-65).

Re claim 5. Spencer further discloses the method wherein the step of establishing the resource comprises the step of negotiating the resource between the inquirer and the consultant (see the qualifying questions in fig.15, fig.21A, and fig.21B).

Re claim 6. Spencer further discloses the method further comprising the step of establishing a profile of the consultant or the inquirer (i.e., a list of recipients for the created RFP is compiled, E-mail, phone number, address and other pertinent information are entered in this step, see col.13, lines 35-45, also see col.4, lines 40-55).

Re claim 7. Spencer further discloses the method, further comprising the step of verifying the profile of the consultant (i.e., once a user (creator or respondents) is properly logged in and the user's password is verified, see col.8, lines 10-20).

Re claim 8. Claim 8 simply combines the limitations recite in claims 6 and 7 supra, and thus rejected using the same rationale in claims 6 and 7.

Re claim 9. Spencer further discloses the method further comprising the step of matching a consultant with an inquirer based upon a pre-established profile of at

Art Unit: 3692

least one of the consultant and the inquirer (i.e., The system automatically directs users to their customized web site interface based upon the log in ID. RFP creators are directed to the creator and analysis section while respondents are directed to the response section, see col.11, lines 2-15, also the present invention includes computer programs for searching and templates for creating new RFPs that are specific to particular industries such as employee benefits and manufacturing industries, see col.6, lines 5-10).

Re claims 10 and 11. Claims 10 and 11 recite similar limitations to claim 9, and thus rejected using the same art and rationale in the rejection of claim 9.

Re claim 12. Spencer further discloses a communications network having a client machine and a server, a method for responding to an inquiry by an inquirer in exchange for a resource, said method comprising the steps: providing the inquirer with access to the communications network to furnish the inquiry that requires a response, providing the consultant with access to the communication network for responding to the inquiry of the inquirer, and exchanging a resource between the consultant and the inquirer in response to the consultant responding to the inquiry (see abstract, also see fig.1). Spencer does not explicitly disclose providing an inquirer and a consultant with access to the communications network for to determining a resource exchangeable for a response to an inquiry. However, Walker discloses providing an inquirer and a consultant with access to the communications network for to determining a resource exchangeable for a

response to an inquiry (i.e., the central controller determines one or more upsells that correspond to the upsell offer condition. The upsells may be, for example, products complementary to previously-purchased products. The upsells are offered to the account holder by printing onto the billing statement indicia that specifies the upsells. Upon receiving an indication that an upsell was accepted, the upsell is provided to the account holder. The account holder may accept the upsell by appropriately modifying the billing statement and returning the statement with payment. The upsell is then provided, typically in the form of a reduced price at a point-of-sale terminal or a discount on a subsequent billing statement, see the abstract, also see col.5 lines 20-40. The examiner asserts that although it is stated that the account holder can respond to the upsell offering by manually modifying the billing statement, however, in a separate embodiment taught by Walker, the process can be achieved electronically, see col.7 lines 45-50). Thus it would have obvious to one of ordinary skill in the art to combine the teachings of Spencer and Walker to generate sales to customers.

Re claim 13. Spencer further discloses a system for responding to an inquiry by an inquirer in exchange for an established resource, comprising: an inquiry facility for providing the inquirer having an inquiry that requires a response, a consultant facility for providing a consultant for responding to the inquiry of the inquirer, and an exchange facility for exchanging a resource between the consultant and the inquirer in response to the consultant responding to the inquiry (see abstract, also see fig.1 and fig.2). Spencer does not explicitly

disclose a resource determination facility for determining a resource exchangeable for a response to an inquiry. However, Walker discloses a resource determination facility for determining a resource exchangeable for a response to an inquiry (i.e., the central controller determines one or more upsells that correspond to the upsell offer condition. The upsells may be, for example, products complementary to previously-purchased products. The upsells are offered to the account holder by printing onto the billing statement indicia that specifies the upsells. Upon receiving an indication that an upsell was accepted, the upsell is provided to the account holder. The account holder may accept the upsell by appropriately modifying the billing statement and returning the statement with payment. The upsell is then provided, typically in the form of a reduced price at a point-of-sale terminal or a discount on a subsequent billing statement, see the abstract, also see col.5 lines 20-40. The examiner asserts that although it is stated that the account holder can respond to the upsell offering by manually modifying the billing statement, however, in a separate embodiment taught by Walker, the process can be achieved electronically, see col.7 lines 45-50). Thus it would have obvious to one of ordinary skill in the art to combine the teachings of Spencer and Walker to generate sales to customers.

Re claim 14. Spencer further discloses the system further comprising a communications network for allowing the consultant to respond to the inquiry (see abstract, also see fig.1 and fig.2).

Re claim 15. Claim 15 recites similar limitations to claim 2, and thus rejected

using the same art and rationale in the rejection of claim 2.

Re claim 16. Claim 16 recites similar limitations to claim 6, and thus rejected using the same art and rationale in the rejection of claim 6.

Re claim 17. Claim 17 recites similar limitations to claim 7, and thus rejected using the same art and rationale in the rejection of claim 7.

Re claim 18. Spencer further discloses the system further comprising means for allowing the inquirer to specify the profile of the consultant (see fig.16).

Re claim 19. Claim 19 recites similar limitations to claim 9, and thus rejected using the same art and rationale in the rejection of claim 9.

Re claim 20. Spencer further discloses the system, wherein said matching facility comprises means for establishing a profile of at least one of the consultant and the inquirer, and means for matching the inquirer with the consultant based on the profile (i.e., The system automatically directs users to their customized web site interface based upon the log in ID. RFP creators are directed to the creator and analysis section while respondents are directed to the response section, see col.11, lines 2-15, also the present invention includes computer programs for searching and templates for creating new RFPs that are specific to particular industries such as employee benefits and manufacturing industries, see col.6, lines 5-10).

Re claim 21. Spencer further discloses In a communications network, a business method for responding to an inquiry by an inquirer in exchange for a resource in order to facilitate response to the inquiry, said method comprising the steps of:

accepting the inquiry from an inquirer that requires a response, allowing a consultant to respond to the inquiry of the inquirer, and providing for an exchange of the resource between the consultant and the inquirer in response to the consultant responding to the inquiry (see abstract, see fig.1 and fig.2). Spencer does not explicitly disclose determining a resource exchangeable for a response to an inquiry. However Walker discloses determining a resource exchangeable for a response to an inquiry (i.e., the central controller determines one or more upsells that correspond to the upsell offer condition. The upsells may be, for example, products complementary to previously-purchased products. The upsells are offered to the account holder by printing onto the billing statement indicia that specifies the upsells. Upon receiving an indication that an upsell was accepted, the upsell is provided to the account holder. The account holder may accept the upsell by appropriately modifying the billing statement and returning the statement with payment. The upsell is then provided, typically in the form of a reduced price at a point-of-sale terminal or a discount on a subsequent billing statement, see the abstract, also see col.5 lines 20-40. The examiner asserts that although it is stated that the account holder can respond to the upsell offering by manually modifying the billing statement, however, in a separate embodiment taught by Walker, the process can be achieved electronically, see col.7 lines 45-50). Thus it would have obvious to one of ordinary skill in the art to combine the teachings of Spencer and Walker to generate sales to customers.

Art Unit: 3692

Re claim 22. Claim 22 recites similar limitations to claim 3, and thus rejected using the same art and rationale in the rejection of claim 3.

Re claim 23. Claim 23 recites similar limitations to claim 4, and thus rejected using the same art and rationale in the rejection of claim 4.

Re claim 24. Claim 24 recites similar limitations to claim 6, and thus rejected using the same art and rationale in the rejection of claim 6.

Re claim 25. Claim 25 recites similar limitations to claim 7, and thus rejected using the same art and rationale in the rejection of claim 7.

Re claim 26. Claim 26 recites similar limitations to claim 18, and thus rejected using the same art and rationale in the rejection of claim 18.

Re claims 27 and 28. Claims 27 and 28 recite similar limitations to claim 9, and thus rejected using the same art and rationale in the rejection of claim 9.

Response to Arguments

3. Applicant's arguments with respect to claims 1-28 have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

Art Unit: 3692


A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to OJO O. OYEBISI whose telephone number is (571) 272-8298. The examiner can normally be reached on 8:30A.M-5:30P.M.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, RICHARD E. CHILCOT can be reached on (571)272-6777. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Art Unit: 3692

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.


FRANTZY POINVIL
PRIMARY EXAMINER
Au 3692